REMARKS/ARGUMENTS

1.) Amendments

The Applicants have amended claims 1-3 and 7-9; claims 4-6 and 10 have been cancelled. Claims 1-3 and 7-9 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Allowable Subject Matter

The Examiner stated that claim 7 would be allowable if rewritten to overcome rejections under 35 U.S.C. §112, and to include all limitations of its base claim and any intervening claims. The Applicants thank the Examiner for the indication of allowable subject matter. The Applicants, however, believe the base claim for claim 7 is allowable and, therefore, decline to so amend claim 7.

3.) Examiner Objections

a.) Drawings

The Examiner objected to the drawings as failing to comply with 37 C.F.R. §1.83(a). The Applicants note for the Examiner that 37 C.F.R. §1.81 provides that a drawing of the invention is to be furnished "where necessary for an understanding of the subject matter sought to be patented." (emphasis added) Whereas the Applicants believe the drawings currently in the application are sufficient to adequately illustrate the invention and that no further drawings are *necessary* for an understanding of the subject matter sought to be patented, the Applicants traverse the objection to the drawings.

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The Applicants note that the novel functions of their invention are referenced in Figure 2 by the signal references "a," "b" and "c." Those novel functions ("information flow") are particularly described on page 6, beginning at line 13. One of ordinary skill in the art would understand how to practice the Applicants' invention by reviewing the drawings in combination with the detailed description of the invention and, therefore, the Applicants respectfully request that the Examiner withdraw the objection to the drawings.

b.) Specification

The Examiner objected to the abstract of the disclosure on the asserted basis that it is "too vague." The Applicants submit herewith a new Abstract that conforms to the claimed invention.

c.) Claims

The Examiner objected to claims 8, 9 and 10 as being in improper form. Claim 10 has been cancelled and claims 8 and 9 have been amended to remove the mutual dependency.

4.)   Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 2-6 on the asserted basis that they fail to comply with the enablement requirement; i.e., that the claims contain subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains to practice the invention. Claims 4-6 have been cancelled and, therefore, the Examiner's rejection as to those claims is moot. The Applicants traverse the rejection with respect to claims 2 and 3.

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Claim 2 recites:

> 2. Method as claimed in claim 1,
> wherein said IN service is adapted to find the closest gateway (GW) by analyzing the calling party (A) number, each of said plurality of gateways being associated with geographic areas associated with calling party locations.

One skilled in the art would understand from the Applicants disclosure how a closest gateway can be selected as a function of the calling party number, where each gateway is associated with a geographic area associated with calling party locations. A calling party location can be, for example, related to an area code associated with the calling party. The Applicant discloses beginning on page 7, line 25, how to locate a gateway as a function of a called party number; one skilled in the art would readily understand how to apply the same procedures to a calling party number. Therefore, the subject matter of claim 2 is described in the specification in such a way as to enable one skilled in the art to which it pertains to practice the invention.

Claim 3 recites:

> 3. Method as claimed in claim 1, further comprising the step of:
> after the IN service has established the call to the first gateway (Gwa) there is in the call set-up included the associated gateway number (Gwa) as destination number, as well as the calling party (A) number and the called party (B) number.

The Applicants disclose, beginning on page 8, line 13, an information flow (depicted in Figure 2), wherein the call setup messages for a call routed to a gateway (Gwa) includes the calling party number (A-number), the called party number (Gwa-number) and a redirecting number (for the called party; B-number). The Applicants' disclosure states that the call setup process can be performed using ISUP, which those skilled in the art are familiar with. Therefore, the subject matter of claim 3 is described in the

specification in such a way as to enable one skilled in the art to which it pertains to

practice the invention.

5.)   Claim Rejections – 35 U.S.C. §102(a)

The Examiner rejected claim 1 as being anticipated by United States Patent No.

6,597,686 issued to Smyk. Whereas Smyk fails to disclose each and every limitation of

claim 1, the Applicants traverse the rejection.

Claim 1 recites:

> 1.   Method for setting up telephone-to-telephone calls
> using telephones connected to a PSTN/ISDN access network and
> using a separate packet-switched network as a by-pass network,
> wherein telephone gateways (GW) provide bridges between the
> access network and said by-pass network, and connections being
> established between a calling party (A) telephone and a first
> gateway (GWa) and between a second gateway (GWb) and a
> called party (B) telephone, said method comprising the steps of:
> dialing, by a calling party (A) in a one-step procedure, a by-
> pass network service prefix together with the number of a called
> party (B), said by-pass network service prefix comprising an IN-
> service prefix, and
> analyzing said by-pass network service prefix to identify the
> relevant IN service for thereby routing the call to an IN node which
> can execute this IN service, the IN service establishing a call to
> said first gateway (GWa) selected from one of a plurality of
> gateways (GW), whereby said first gateway is made service
> transparent to the calling party (A). (emphasis added)

Smyk fails to disclose dialing a by-pass network service prefix together with the

number of a called party. The Examiner refers to Figure 9 as showing that feature.

Figure 9, however, is a flow diagram of the sequence of steps shown in Figure 8. With

respect to Figure 8, Smyk states that "the caller dials the telephone number of the called

party (step 802)." (column 6, line 26-27). Thus, Smyk does not disclose the use of a by-

pass network service prefix together with the number of a called party to control the routing of a call through a packet-switched network.

The Examiner also alleges that Smyk discloses a "prefix 704 (calling party's preference number; see col. 5, ln. 48-65) + B-number 702 (called party's telephone number." At column 5, lines 48-55, however, Smyk states that: "Service control point 404 preferably reviews preference information established for the calling party's telephone service (step 704). This preference information can take the form, for example, of a customer profile for calls originating from telephone 402 indicating a default carrier for all domestic calls and a default carrier for international calls that cannot be routed through a telephone service carrier providing Internet voice communication." (emphasis added) The "preference information," or customer profile, is not the same as the "by-pass network service prefix" disclosed and claimed by Applicants. In particular, it is noted that the "preference information" described by Smyk is not dialed by a calling party together with the number of a called party (B), nor does it comprise an IN-service prefix. Therefore, Smyk fails to anticipate claim 1.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-3 and 7-9.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,
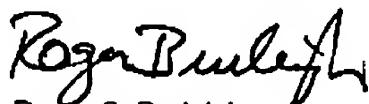
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ABSRACT

Method for setting up telephone-to-telephone calls using telephones connected to a PSTN/ISDN access network and using a separate packet-switched network as a by-pass network, wherein telephone gateways (GW) provide bridges between the access network and the by-pass network, and connections are established between a calling party (A) telephone and a first gateway (GWa) and between a second gateway (GWb) and a called party (B) telephone. The method includes the steps of: dialing, by a calling party (A) in a one-step procedure, a by-pass network service prefix together with the number of a called party (B), wherein the by-pass network service prefix includes an IN-service prefix; and analyzing the by-pass network service prefix to identify the relevant IN service for thereby routing the call to an IN node which can execute the IN service, the IN service establishing a call to a first gateway (GWa) selected from one of a plurality of gateways (GW), whereby the first gateway is made service transparent to the calling party (A).